

Applicant : James R. Cole et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/629,065
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Attorney's Docket No.: 200208981-1
Alt. Ref.: 00116-001100000

REMARKS

Applicants wish to thank the Examiner for the allowance of claims 1-8 and 31 and conditional allowance of claims 9,11-16 and 32. While we have received a final rejection on claims 17-30, we respectfully submit that our response addresses the Examiner's concerns and places the claims above in condition for allowance; accordingly we urge the Examiner to consider withdrawing the aforementioned rejection and also allow claims 17-30.

In the office action mailed August 11, 2005, the Examiner objected to claims 9, 11-16 and 32 as lacking antecedent basis for the term "predetermined threshold". Applicant has revised claim 9 and 32 to refer to "a predetermined threshold" instead. Defendant claims 11-16 should also be cured of this objection by virtue of their dependency on claim 1. Accordingly, Applicant would respectfully request withdrawal of the objections concerning claims 9, 11-16 and 32.

Claims 17-30 stand rejected under 35 USC 102(e) over US Patent 6,702,444 to Takizawa et al (hereinafter Takizawa). Applicant respectfully submits that Takizawa alone does not teach or suggest any aspect of the present invention. Takizawa describes a way of lowering fan noise and keeping a light source or lamp from overheating and possibly becoming damaged (Abstract). Once a light source is turned on, the heat produced by the light source is monitored with temperature sensors and the fan speeds are set to different speeds depending on the heat output. (Col. 9, lines 45-67). Takizawa is concerned with turning off the lamp when the heat output from the lamp is too great but is not concerned with temperatures before turning the lamp on. (see Col. 9, lines 57-62 of Takizawa, "the first intake fan 17A and the second intake fan 17B are controlled to rotate at low speed during the standby period and to rotate at high speed after the

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standby period, regardless of the temperatures detected by the temperature sensors").

Applicant submits that a proper § 102 rejection from a single prior art reference must have every element of the claim. See Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2D (BNA) 1913, 1920 (Fed. Cir.), cert. denied, 493 U.S. 853, 107 L. Ed. 2d 112, 110 S. Ct. 154 (1989) (explaining that an invention is anticipated if every element of the claimed invention, including all claim limitations, is shown in a single prior art reference). See Jamesbury Corp. v. Litton Industrial Products, Inc., 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985) (explaining that the identical invention must be shown in as complete detail as is contained in the patent claim). The Examiner has admitted that Takizawa does not expressly disclose every element of the claims at issue.

Further, the Examiner has incorrectly relied on inherency to fill in these admittedly missing elements in Takizawa. Consequently, the Examiner cannot maintain a § 102 rejection. Specifically, the Examiner noted in the instant office action, "it is irrelevant if Takizawa performs the claimed functions, only that Takizawa teaches components that are capable of performing the claimed functions". This is clearly not the law as almost every possible function can be either implemented or simulated on a general purpose computer. Accordingly, no apparatus claims involving computations or control systems would be patentable if the Examiner's logic were so applied..

Instead, the test for using inherency as a basis for a § 102 rejection is much more rigorous and difficult. Contrary to the Examiner's assertion, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of

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conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

The Examiner has misapplied *In re Schrieber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997), to stand for the proposition that one only need the components capable of performing a function to actually anticipate the function. Instead, this determination is much more fact specific than interpreted by the Examiner. It greatly depends on the complexity of the subject matter and degrees of freedom or variation encompassed with the technology at hand. In the Schrieber case, the court affirmed a finding that a prior patent to a conical spout used primarily to dispense oil from an oil can inherently performed the functions recited in applicant's claim to a conical container top for dispensing popped popcorn. The Examiner in Schrieber had asserted inherency based on the structural similarity between the patented spout and applicant's disclosed top, i.e., both structures had the same general shape. Clearly, a conical spout is simple device having a fixed structure and can only be used for funneling a material (whether it is popcorn or motor oil) from the mouth of a larger container through a small hole at the end of the spout.

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However, the controller in the present case of Takizawa is complex and can be programmed in many different ways and has no fixed structure. The Examiner admits that Takizawa does not show each and every element of the claims rejected nor does it provide any details hence it cannot inherently anticipate the rejected claims. Further, the Examiner cannot rely upon inherency as there have been no facts or technical reasoning provided that a system as recited in Claim 17 is provided as a necessary consequence of the design in Takizawa. On the contrary, the Examiner's admission that Takizawa could be programmed to operate in almost any manner (August 11, 2005 Office Action, page 10, lines 15-17) indicates that Takizawa cannot reasonably have any inherent functional details but only those expressly disclosed.

It also appears that the Examiner has misconstrued MPEP 2114 and the brief description of *In re Schreiber* contained therein. It is true that MPEP 2114 states, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" *In re Schrieber*, 128 F.3d 1477-78, 44 USPQ2d 1429 1431-32 (Fed. Cir. 1997). However, the MPEP 2114 portion the Examiner omitted further provides the holding and critical application of this rule. Specifically, MPEP 2114 further instructs that "The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because (emphasis added) the limitations at issue were found to be inherent in the prior art reference"; see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959)."

Referring to *In re Swinehart* provides an even more express interpretation for the courts and examiners applying MPEP 2114 stating, "where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject

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matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the application to provide that the subject matter shown to be in the prior art does not possess the characteristics relied on." *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971); Accordingly, MPEP 2114 instructs that the Examiner that if function is the basis to distinguish over the prior art that it may be found inherently rather than expressly. Unfortunately, the Examiner has not provided sufficient technical reasoning or facts to show inherency in Takizawa to anticipate claim 17 as described previously. The Examiner must therefore withdraw this rejection as the admitted missing limitations in Takizawa are not inherent by design.

Even though they are independently patentable, claims 18-28 also remain patentable by virtue of their dependency on independent claim 1. Independent claims 29 and 30 are at least patentable for some or all of the reasons provided with respect to claim 1 and claim 17.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Leland Wiesner, Applicants' Attorney at (650) 853-1113 so that such issues may be resolved as expeditiously as possible.

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For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

10/05/2005

Date

Respectfully Submitted,



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